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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,146	02/28/2002	Robert F. Bigelow JR.	0112300-740	4138

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EXAMINER

WHITE, CARMEN D

ART UNIT	PAPER NUMBER
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3714

DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,146

Applicant(s)

BIGELOW ET AL.

Examiner

Carmen D. White

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-62 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1 and 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claims 17-30 are objected to because of the following informalities: Line 15 recites "based the symbols". Similarly, claim 61, line 12 recites this informality in the claim. There appears to be a missing word between "based" and "the". The examiner suggests including the word —on—for claim clarity. Appropriate correction is required.

Claims 31-38 are object to because of the following informalities: Line 10 of the claim recites "including". This appears to be a typographical error. For claim language clarity, the examiner suggests changing "including" to —included--.

Claims 39-51 are objected to because of the following informalities: Line 10 recites "based the symbols". Similarly, see line 2 of claim 42. There appears to be a missing word between "based" and "the". The examiner suggests including the word —on—for claim clarity. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-30, 52 and 58-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-16 recite the limitation "the occurrence" in line 9. There is insufficient antecedent basis for this limitation in the claim.

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Claim 7 recites the limitations "the first free spin" and "the previous free spin" in lines 2-4. There is insufficient antecedent basis for this limitation in the claim.

Claims 17-30 recites the limitations "the first free spin" and "the previous free spin" in lines 9-10. There is insufficient antecedent basis for this limitation in the claim.

Claims 17-30 recites "the occurrence" line 12. There is insufficient antecedent basis for this limitation in the claim.

Claim 52 recites "the occurrence" line 7. There is insufficient antecedent basis for this limitation in the claim.

Claims 58-60 recite "repeating steps (a) to (h) until there are no free spins remaining" in the last 2 lines of the claim (step (i)). There is insufficient antecedent basis for the "free spins" limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-4, 6, 39, 41-43, 52-53 and 61-62 are rejected under 35 U.S.C. 102(e) as being anticipated by **Locke** et al (6,561,904).

Regarding claims 1, 3-4, 6, 39, 41-43, 52-53 and 61-62, Locke teaches a gaming device that comprises a plurality of reels; a plurality of symbols on the reels; a triggering

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event associated with at least one of the symbols or a combination of the symbols occurring on the reels; a plurality of free spins of the reels; a plurality of multipliers associated with the free spins of the reels; and a processor which controls the reels whereupon an occurrence of the triggering event on the reels, the processor provides the free spins of the reels to a player and determines an award, if any, to provide to the player for each free spin based upon the symbols occurring on the reels from the free spin and the multiplier associated with the free spin, wherein the multiplier changes at least once during the free spins (abstract; col. 1, lines 49-62; col. 2, lines 55-67).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 5, 7-38, 40, 44-51 and 54-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Locke** et al (6,561,904).

Regarding claims 2, 40, Locke teaches the limitations of the claims as recited above. Locke is silent regarding the number of the free spins being predetermined. The examiner takes notice that it is well known in the art to have features preset/predetermined in slot machines. This makes it easier to predict outcomes and payouts for the gaming establishment. Therefore results in the gaming establishment not losing excessive amounts of money. It would have been obvious to a person of

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ordinary skill in the art at the time of the invention to modify Locke to include this feature for this reason.

Regarding claims 5, 44, Locke teaches the limitations of the claims as recited above. Locke is silent regarding the feature of the number of free spins being determined by the player choosing masked selections. The examiner takes notice that it is well known for the players to choose masked selections in a slot gaming device. It increases the element of surprise; thereby increasing player participation and anticipation. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include this feature in Locke with the free spin feature for these reasons.

Regarding claims 7-13, 15, 17, 45-51, 54-57, Locke teaches the limitations of the claims as recited above. Locke is silent regarding the explicit teaches of the multiplier features as disclosed in the instant claims. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include random increases of the multipliers associated with the free spins in order to make the payout less predictable for the players thereby promoting increased play and excitement.

Regarding claims 14, 16, 31-38, 58-60, Locke teaches all the limitations of the claims as discussed above. Locke lacks teaching an incrementor symbol. It would have been obvious to a person of ordinary skill in the art at the time of the invention to employ this symbol as one of the symbols of Locke in order to provide increased excitement and anticipation of the game. This would merely involve programming the software to include this symbol with the current symbols of Locke.

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Regarding claims 18-30, Locke teaches all the limitations of the claims as discussed above. Locke is silent on the feature of a consolation prize. However, the examiner takes notice that it is known in the art to give consolation prizes in the gaming art. This provides the players with a cheerful feeling in the event of monetary losses; thereby, making the player want to play the game again and risk wagering. Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention to incorporate this feature into Locke for this reason.

USPTO Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carmen D. White whose telephone number is 703-308-5275. The examiner can normally be reached on Monday through Friday, 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1078.


Carmen White
Patent Examiner
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